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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,934	08/31/2000	Francisco Morales Serrano	PHD 99-112	3252

7590

12/17/2002

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EXAMINER

BUDD, MARK OSBORNE

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

652 934

Applicant(s)

Serrano et al

Examiner

M. Budd

Group Art Unit

2834

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11-4-02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2834

Claims 1-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are vague, indefinite and inaccurate in citing "control electrode is designed for supplying a feedback signal ---". This implies some special structure of the electrode to perform this function, wherein in fact the electrode structures disclosed and illustrated are unremarkable. The means that allows either a drive function or feedback function is not the electrode construction; it is the switches and drive circuit elements that allow the alternating drive and feedback functions. Thus the claims are vague, indefinite and inaccurate and one cannot properly determine their metes and bounds.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8 and 10 rejected under 35 U.S.C. 102(a) as being anticipated by O'Brien or Zumeris.

Both references teach the specific piezoelectric motor structure and a drive circuit that can switch directions (supplying control signals) and a regulating circuit (e.g. #42, #44, #48 & #50 of O'Brien; #58, #60, #62, #64 & #66 of Zumeris). It is noted that the functional phrases "characterized in that "and" is designed for" have not been given patentable weight as they add

Art Unit: 2834

no additional structural limitations. Courts have found that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F. 2d 844, 847. Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v Bausch & Lomb Inc., 909 F2d 1464, 1469. Note too, that it is not possible to get into the designers head to determine what something was designed for.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Zumeris or O'Brien in view of Diefenbach.

This claim adds that the driven member is a shaving head. Selecting the final use for a motor would be within the skill expected of the routineer. Diefenbach teaches the specific motor structure used by O'Brien and Zumeris can be used to drive a shaver head. Thus to put Zumeris or O'Brien to this use would have been obvious to one of ordinary skill in the art.

The restriction requirement is hereby withdrawn in view of both applicants comments and the discovery that the prior art search areas were the same for all species.

Further cited of interest are Suganuma and Atsuta (both teach using one piezo element as both a drive and feedback element to eliminate the need for additional feedback electrodes or elements).


Application/Control Number: 09/652,934

Page 4

Art Unit: 2834

M BUDD/pj

12/13/02


MARK J. BUDD
PRIMARY EXAMINER
ART UNIT 212